

REMARKS

The comments of the applicant below are each preceded by related comments of the examiner (in small, bold type).

1. Claim 79 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. As disclosed, the claim is directed towards a knowledge-based system, but is dependent upon a method for providing information. Due to this dual representation, it is difficult to determine if the claim is intended to further define the aforementioned method as claimed in independent claims 73 and 81, or further define the above-mentioned system as disclosed in independent claims 1 and 42.

Claim 79 has been amended.

3. Claims 73-80 are rejected under the judicially created doctrine of double patenting over claims 25-30 of U. S. Patent No. 6,633,859 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

A method of providing information whereby accessing a presentation template that references at least one knowledge block, using a compiler to incorporate information into the presentation template, and displaying the presentation to a user.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into a patent.

The applicant respectfully disagrees. Claim 73 recites "the presentation template and the incorporated information in a format designed to facilitate comparative analysis." There is no double patenting because claims 25 through 30 of the '859 patent make no reference to comparative analysis. Furthermore, contrary to the examiner's contention, the '859 patent does not describe that "the presentation template and the incorporated information in a format designed to facilitate comparative analysis." Therefore it appears that claim 73 could not have been made in the issued patent.

The applicant calls the examiner's attention to the fact that claim 25 of the '859 patent had been rejected by the examiner based on Orr, U.S. 5,903,902, one of the references included in the information disclosure statement filed on July 9, 2004.

5. Claims 73-80 are rejected under 35 U.S.C. 102(e) as being anticipated by Farlow et al., U.S. Patent No. 6,633,859 [hereafter Farlow].

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As per claim 73, Farlow et al teaches of a method of providing information, the method comprising the steps of:

A. accessing a presentation template that references at least one knowledge block (see column 10, lines 50-56);

B. incorporating information into the presentation template by means of a compiler based on the contents of the at least one knowledge block referenced by the presentation template (see column 10, lines 60-63); and

C. displaying a presentation to a user comprising the presentation template and the incorporated information in a format designed to facilitate comparative analysis (see figure 7; column 8, lines 40-53; and column 10, lines 65-67).

The applicant respectfully disagrees. With respect to the clause of claim 73 that recites "displaying a presentation to a user comprising the presentation template and the incorporated information in a format designed to facilitate comparative analysis," figure 7 of Farlow shows an "information repository in which plan-specific and employee group-specific variable assignments are provided" (column 5, beginning at line 53); figure 7 does not show a presentation of information to a user. User presentations are shown in figures 2A, 2B, 3A, and 3B of Farlow, but they are not in "a format designed to facilitate comparative analysis." Contrast those figures with the comparison table in figure 2 of the present application and the related text beginning at line 12 of page 16. Farlow did not anticipate claims 73 through 80.

6. Claims 1-72 and 81-85 are allowed.

7. The following is a statement of reasons for the indication of allowable subject matter:

the cited prior art fails to explicitly teach of a knowledge-based comparative information dissemination system consistent with the limitations of independent claims 1, 42, and 81, wherein a compiler is employed in accessing and making available to a user, multiple instantiations of a knowledge model based upon queries from a system user with a defined context.

The applicant acknowledges the allowance of claims, and notes that the recitation by the examiner is not exactly consistent with the wording of relevant portions of all of claims 1, 42, and 81. Also, there may be other good reasons why claims 1-72, 81-85, and other claims are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicant has (a) addressed certain comments of the examiner does not mean that the applicant concedes other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended a claim does not mean that the applicant concedes any of the examiner's positions with respect to that claim or other claims.

Enclosed is a \$52.00 check for excess claim fees. Please apply any other charges or credits to deposit account 06-1050, referencing 12579-002001.

Date: _____

8/5/00

Respectfully submitted,

David L. Feigenbaum
Reg. No. 30,378

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906
20871135.doc